

under 35 U.S.C. 103(a) as being unpatentable over Collins in combination with the so-called admitted prior art and in view of Nilsen, Giles, Zabrocki, Hull, and Adur, and further in view of Grimm et al. (U.S. Patent No. 5,856,371) and Perry et al. (U.S. Patent No. 6,221,436-B1).

In this response, no claims have been amended or cancelled. Thus, claims 1-37 remain pending. Applicants respectfully request the Examiner to reconsider the present application.

Claim Rejections – 35 U.S.C. 103

Claims 1-2, 5-7, 10-11, and 14 were rejected as being unpatentable over Collins.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Manual of Patent Examining Procedure (MPEP) ¶ 2143.03).

Independent claims 1 and 15 include limitations that are not disclosed, suggested, or motivated by Collins. As a result, independent claims 1 and 15 are patentable over Collins.

In particular, independent claims 1 includes the limitations of “applying a protective barrier to at least a part of the plastic piece; and molding a rubber layer onto at least the part of the plastic piece over the protective barrier.” Such limitations are not disclosed by Collins. Rather Collins discloses a soft coated shaped polycarbonate articles exhibiting improved resistance of the polycarbonate substrate to degradation by the plasticizers contained in the relatively soft top coat. Collins further fails to disclose molding a rubber layer onto at least the part of the plastic piece over the protective barrier.

Similarly, independent claim 15 includes the limitation of “applying a liquid solution to at least the part of the plastic piece; curing the liquid solution to form a polyurethane coating on at least the part of the plastic piece; and molding the rubber layer onto at least the

part of the plastic piece over the polyurethane coating.” Such limitations are also not disclosed by Collins. As a result, independent claims 1 and 15 are patentable over Collins.

The Examiner stated that claims 1-2, 5-7, 10-11, and 14 were rejected as being unpatentable over Collins in view of admitted prior art (Admission). The Examiner further stated that “Admission further teaches, “Translucent polycarbonate pieces with translucent rubber overmoldings include computer casings such as those incorporated into iBook® portable computers available from Apple Computer, Inc. ®.” (Page 4, lines 14-16 of the instant specification”. The Examiner further included more specification (e.g., Page 4, lines 17-24) as admission of prior art.

Applicants respectfully submit that, however, these so-called admissions are not admissions of prior art, rather these are part of the specification for the presently claimed invention. Applicants submit that Page 4 of the specification is not part of the background section; rather, it is part of the detailed description section of the specification of the invention. The applicants respectfully submit that it would not be appropriate to use hindsight to find the motivation to combine references by using an applicant’s own teachings against that applicant. Further, it is not appropriate to use applicants’ specification as prior art against the applicants.

An examiner “must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998.) (Also see MPEP 2142 as well as MPEP 2145).

“Our [Federal circuit] case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” In re Lee, No. 07/631,240, (Fed. Cir. Jan. 2002).

“Because the Board did not explain the *specific understanding* or principle *within* the knowledge of a skilled artisan that would motivate one with no knowledge of Rouffet’s [Appellant’s] invention to make the combination, this court infers that the examiner selected these references with the assistance of hindsight.” In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998.).

As acknowledged by the Examiner, Collins does not specifically teach that the plastic (polycarbonate) piece is part of a casing, or the overmolding of the rubber layer over the intermediate protective layer, nor do Collins and other cited references suggest such limitation. The suggestion based on Collins in view of the specification of the present invention constitutes impermissible usage of hindsight to find the motivation to combine references by using an applicant’s own teachings against the applicant. As a result, independent claim 1 is patentable over Collins and other cited references. Dependent claims 2-14 depend from claim 1, and thus include all of the limitations of claim 1, and therefore are patentable over Collins for the reasons discussed above. Applicants respectfully request the Examiner to withdraw the rejection and to allow the application.

Similarly, independent claim 15 includes the limitation of “curing the liquid solution to form a polyurethane coating on at least the part of the plastic piece; and molding the rubber layer onto at least the part of the plastic piece over the polyurethane coating”. The Examiner stated that claims 15-37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Collins in view of admitted prior art (Admission). As discussed above, such admission is a description of the invention, rather than an admission of prior art. Neither Collins nor other cited references disclose, teach, or suggest the limitation of “curing the liquid solution to form a polyurethane coating on at least the part of the plastic piece; and molding the rubber layer onto at least the part of the plastic piece over the polyurethane coating”. Therefore, for similar reasons discussed above, independent claim 15 is patentable over Collins and other cited references. Dependent claims 16-37 depend from independent claim 15, thus include the

limitations of independent claim 15, and therefore are patentable over Collins and other cited references for the reasons discussed above. Applicants respectfully request the Examiner to withdraw the rejection.

Condition for Allowance

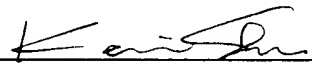
Applicants respectfully submit that all rejections have been overcome and the present application is in condition for allowance. If a telephone interview would in any way expedite the prosecution of this application, the Examiner is invited to contact the undersigned attorney at (408) 720-8300.

Please charge Deposit Account No. 02-2666 for any shortage of fees in connection with this response.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

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